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Applicants: Francois Maltais et al.
Application No.: 10/798,766

REMARKSThe Claim Amendments

Claim 14 has been amended to recite a composition of the invention, additionally comprising a therapeutic agent selected from a list of specific chemotherapeutic or anti-proliferative agents. Support for this amendment is found in paragraph [00157] on pages 53-54 of the specification.

Claim 15 has been amended to recite a method of inhibiting kinase activity in a biological sample selected from a cell culture, saliva, urine, feces, semen, tears, or an extract thereof. Support for this amendment is found in paragraph [00163] on pages 55-56 of the specification.

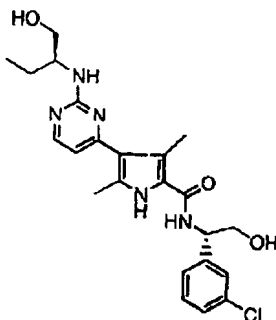
Claims 13, 16, and 19-29 have been canceled

None of the amendments contain new matter. Their entry is requested.

Applicants preserve the right to continue to prosecute and to obtain claims to the canceled matter either in this application or in other applications claiming benefit herefrom.

The Restriction Requirement

The Examiner has limited the scope of the invention to the elected species (compound I-51), which has the following structure:



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Furthermore, the Examiner asserts that the withdrawn subject matter is patentably distinct from the elected subject matter as it differs in the structure and element and would require separate search considerations.

Applicants traverse because the Examiner is making a restriction requirement for each species encompassed by the elected invention. Under 37 CFR § 1.141(a), more than one species of an invention may be specifically claimed in an application provided that the application also includes an allowable generic claim to all claimed species.

In the instant application, (i) each claimed species falls within the scope of generic formula I of claim 1, and (ii) the number of species claimed is not unreasonable and would not constitute an undue search burden on the Examiner.¹ In addition, a restriction based upon a single species would prevent Applicants from properly claiming their invention. See MPEP § 803.02. The instant invention encompasses all species defined in the claims, including certain species that have not been exemplified in the specification. Thus, restriction of the invention to a single disclosed species would prevent applicants from claiming those aspects of their invention for species that are encompassed by the generic claims but are not specifically disclosed. For these reasons, applicants respectfully request that the Examiner withdraw the restriction requirement as it relates to the elected species. Applicants also request that the Examiner acknowledge claim 1 as a linking claim and fully examine claims 2-14 upon finding the elected species allowable. Under the Manual of Patent Examination Procedure (MPEP) § 809, "[w]hen all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn. Any claim(s) directed to the nonelected invention(s),

¹ A search of the entire subject matter of the invention claimed in the corresponding PCT application has been conducted by the European Patent Office, as indicated in the International Search Report submitted with the Information Disclosure Statement filed on January 13, 2005 for the instant application. Five references of particular interest, three of which postdate the priority date of the invention, were cited in the Search Report.

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previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability."

The Response

The rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-7 and 9-14 under 35 U.S.C. § 103(a) as allegedly being obvious over Cao et al., U.S. Patent No. 6,743,791 (hereafter, "the '791 patent").

Applicants disagree that the '791 patent renders the instantly claimed compounds obvious. However, in order to expedite prosecution, applicants submit that the '791 patent and the instant application were both owned or subject to assignment to Vertex Pharmaceuticals Incorporated at the time that the instant invention was made. Since the cited reference is available as a reference only under 35 U.S.C. § 102(e), applicants request that the rejection under 35 U.S.C. § 103(a) be withdrawn in accordance with 35 U.S.C. § 103(c).

The rejections under obviousness-type double patenting

The Examiner has rejected claims 1-7 and 9-14 as being unpatentable over claims 1-2 and 22-23 of the '791 patent and provisionally rejected claims 1-7 and 9-14 as being unpatentable over claims 20 and 41-42 of copending U.S. Patent Application Serial No. 10/770,814 (hereafter the '814 application) under the judicially created doctrine of obviousness-type double patenting as being unpatentable.

Applicants disagree that either the '791 patent or the '814 application renders the instantly claimed compounds obvious. However, applicants have provided a terminal disclaimer over the '791 patent and the '814 application, thus obviating this rejection.

The Examiner has also provisionally rejected claims 1-7 and 9-14 under the judicially created obviousness-type double patenting as being unpatentable over claims 1 and 22-23 of copending U.S. Patent Application Serial No. 11/128,870 (hereinafter "the '870 application").

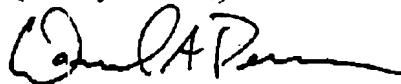
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Applicants do not acquiesce to the Examiner's assertion that the claims of the instant application are obvious over any of the co-pending claims of the '870 application. However, according to MPEP § 804 (I)(B), a provisional double patenting rejection should continue to be made only for so long as there are conflicting claims in more than one application, unless that provisional double patenting rejection is the only rejection remaining in at least one of the applications. Accordingly, if no other substantive matters remain to be resolved in the instant application, applicants request that the provisional double patenting rejection be withdrawn.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and find the elected species allowable. Applicants also request that the Examiner rejoin and examine the non-elected subject matter of claims 1-12 and 14 of Restriction Group I, and allow these claims to pass to issue. Applicants further request that the Examiner rejoin and examine claims 15 and 17-18 of Restriction Group II and allow these claims to pass to issue as well. See MPEP § 821.04(b). Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,



Daniel A. Pearson (Reg. No. 58,053)
Agent for Applicants
Karen E. Brown (Reg. No. 43,866)
Attorney for Applicants
c/o Vertex Pharmaceuticals Incorporated
130 Waverly Street
Cambridge, MA 02139-4242
Tel.: (617) 444-6790
Fax.: (617) 444-6483